REMARKS

In the Final Office Action, the Examiner stated that claims 11-26 are pending in the application and that claims 11-26 stand rejected. None of the Applicant's claims are amended by this response.

In view of the following discussion, the Applicant respectfully submits that none of these claims now pending in the application are rendered obvious under the provisions of 35 U.S.C. § 103. Thus the Applicant believes that all of these claims are now in allowable form.

Rejections

A. 35 U.S.C. § 103

The Examiner rejected claims 11-23, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Logan et al. (U.S. Patent 5,371,551, hereinafter "Logan") in view of Hrusecky (U.S. Patent 6,317,164). The rejection is respectfully traversed.

The Examiner alleges that regarding claims 11, 17 and 21, Logan teaches a digital video system including almost all of the elements of the Applicant's claims 11, 17 and 21 but that the Applicant's claims 11, 17 and 21 differ from Logan in that the claims further require wherein the multiplexer comprises a first switch, which selectively couples the decoder directly to the encoder or to the digital source such that the first digital stream from the encoder is able to be communicated to the decoder without prior recording. The Applicant respectfully agrees that Logan fails to teach at least the above identified limitation of at least the Applicant's claims 11, 17 and 21.

The Examiner however cites Hrusecky for teaching a decoder directly coupled to the source in order to decode a plurality of digital video data streams using a single decoder. The Applicant respectfully disagrees.

The Applicant respectfully submits that there is absolutely no motivation or suggestion in either reference for the combination of the references to attempt to teach the invention of the Applicant. More specifically, there is no motivation or suggestion in the invention of Logan for the combination of the references and likewise, the invention of Hrusecky does not expressly or impliedly motivate or

suggest such a combination as required for the combination of references under 35 U.S.C. § 103.

That is, for prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.SQ.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined **only** if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.SQ.2d 1596, 1599 (Fed. Cir. 1988). ***Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention*** Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

The Applicant further submits that even if there was a motivation or suggestion to combine (which the Applicant maintains that there is not), the teachings of Logan and Hrusecky, in any allowable combination, fail to teach, suggest or make obvious the Applicant's invention, at least with regard to the Applicant's independent claims 11, 17 and 21. That is, the teachings of Hrusecky fail to bridge the substantial gap between at least the Applicant's independent claims 11, 17 and 21 and the teachings of Logan.

That is, as conceded by the Examiner, Logan fails to teach, suggest or make obvious at least that the multiplexer comprises a first switch, which selectively couples the decoder directly to the encoder or to the digital source such that the first digital stream from the encoder is able to be communicated to the decoder without prior recording as taught in the Applicant's Specification and claimed by at least the Applicant's independent claims 11, 17 and 21. Hrusecky also fails to teach, suggest or make obvious at least that the multiplexer comprises a first switch, which selectively couples the decoder directly to the encoder or to

the digital source such that the first digital stream from the encoder is able to be communicated to the decoder without prior recording as taught in the Applicant's Specification and claimed by at least the Applicant's claims 11, 17 and 21. That is, Hrusecky discloses a multiplexer (25) comprising a first switch, which selectively couples the decoder (27) to one of a plurality of digital sources such that a third digital stream from the digital source is able to be communicated to the decoder without prior recording. However, the system disclosed by Hrusecky does not include an encoder. Therefore, the multiplexer (25) is not able to couple the decoder (27) to an encoder of a first analogue signal into a first digital stream. Furthermore, the multiplexers (3, 25) disclosed by both Logan and Hrusecky only comprise a single output. This means that by combining the teachings of Logan et al. and Hrusecky et al., a person skilled in the art does not arrive at the digital video system as claimed by at least the Applicant's claims 11, 17 and 21, in which the multiplexer needs to have two outputs for coupling to the decoder and the medium interface. A person skilled in the art would either arrive at a digital video system comprising a multiplexer coupled to the encoder, to the digital source, and to the decoder, or at a digital video system comprising a multiplexer coupled to the encoder, to the digital source, and to the medium interface, or at a digital video system comprising a first multiplexer coupled to the encoder, to the decoder, and to the digital source, and a second multiplexer coupled to the encoder, to the decoder and to the medium interface.

As such and for at least the reasons described above and specifically that Logan and Hrusecky, alone or in any allowable combination, do not teach, suggest or make obvious a digital video recorder including at least an encoder, a decoder, a medium interface, a digital source and "a multiplexer coupled to the encoder and to the decoder and to the digital source and to the medium interface, wherein the multiplexer comprises a first switch, which selectively couples the decoder **directly** to the encoder or to the digital source **such that a signal from the encoder is able to be communicated to the decoder without prior recording**" as taught in the Applicant's Specification and claimed by at least the Applicant's claims 11, 17 and 21, the Applicant respectfully submits that independent claims 11, 17 and 21 fully satisfy the requirements of 35 U.S.C. § 103 and are patentable thereunder.

Furthermore, dependent claims 12-16, 18-20, 22-23, 25 and 26 depend either directly or indirectly from independent claims 11, 17 and 21 and recite additional features therefor. As such and for at least the reasons set forth herein, the Applicant submits that dependent claims 12-16, 18-20, 22-23, 25 and 26 are also not rendered by the teachings of Logan and Hrusecky, alone or in any allowable combination. Therefore the Applicant submits that dependent claims 12-16, 18-20, 22-23, 25 and 26 also fully satisfy the requirements of 35 U.S.C. § 103 and are patentable thereunder.

The Applicant reserves the right to establish the patentability of each of the claims individually in subsequent prosecution.

B. 35 U.S.C. § 103

The Examiner rejected claims 11, 17, 21 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Rigatti (U.S. Patent 6,614,984) in view of Hrusecky. The rejection is respectfully traversed.

The Examiner alleges that regarding claims 11, 17, 21 and 24 Rigatti teaches a digital video system including almost all of the elements of the Applicant's claims but that the Applicant's claims 11, 17 and 21 differ from Rigatti in that the claims further require wherein the multiplexer comprises a first switch, which selectively couples the decoder directly to the encoder or to the digital source such that the first digital stream from the encoder is able to be communicated to the decoder without prior recording. The Applicant respectfully agrees that Rigatti fails to teach at least the above identified limitation of at least the Applicant's claims 11, 17 and 21.

The Examiner however cites Hrusecky for teaching a decoder directly coupled to the source in order to decode a plurality of digital video data streams using a single decoder. The Applicant respectfully disagrees.

The Applicant respectfully submits that there is absolutely no motivation or suggestion in either reference for the combination of the references to attempt to teach the invention of the Applicant. More specifically, there is no motivation or suggestion in the invention of Rigatti for the combination of the references and likewise, the invention of Hrusecky does not expressly or impliedly motivate or

suggest such a combination as required for the combination of references under 35 U.S.C. § 103.

That is, for prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.SQ.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined **only** if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.SQ.2d 1596, 1599 (Fed. Cir. 1988). ***Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention*** Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

The Applicant further submits that even if there was a motivation or suggestion to combine (which the Applicant maintains that there is not), the teachings of Rigatti and Hrusecky, in any allowable combination, fail to teach, suggest or make obvious the Applicant's invention, at least with regard to the Applicant's independent claims 11, 17 and 21. That is, the teachings of Hrusecky fail to bridge the substantial gap between at least the Applicant's independent claims 11, 17 and 21 and the teachings of Rigatti.

That is, as conceded by the Examiner, Rigatti fails to teach, suggest or make obvious at least that the multiplexer comprises a first switch, which selectively couples the decoder directly to the encoder or to the digital source such that the first digital stream from the encoder is able to be communicated to the decoder without prior recording as taught in the Applicant's Specification and claimed by at least the Applicant's independent claims 11, 17 and 21. Hrusecky also fails to teach, suggest or make obvious at least that the multiplexer comprises a first switch, which selectively couples the decoder directly to the encoder or to

the digital source such that the first digital stream from the encoder is able to be communicated to the decoder without prior recording as taught in the Applicant's Specification and claimed by at least the Applicant's claims 11, 17 and 21. That is, Hrusecky discloses a multiplexer (25) comprising a first switch, which selectively couples the decoder (27) to one of a plurality of digital sources such that a third digital stream from the digital source is able to be communicated to the decoder without prior recording. However, the system disclosed by Hrusecky does not include an encoder. Therefore, the multiplexer (25) is not able to couple the decoder (27) to an encoder of a first analogue signal into a first digital stream. Furthermore, the multiplexers (3, 25) disclosed by both Logan and Hrusecky only comprise a single output. This means that by combining the teachings of Logan et al. and Hrusecky et al., a person skilled in the art does not arrive at the digital video system as claimed by at least the Applicant's claims 11, 17 and 21, in which the multiplexer needs to have two outputs for coupling to the decoder and the medium interface. A person skilled in the art would again either arrive at a digital video system comprising a multiplexer coupled to the encoder, to the digital source, and to the decoder, or at a digital video system comprising a multiplexer coupled to the encoder, to the digital source, and to the medium interface, or at a digital video system comprising a first multiplexer coupled to the encoder, to the decoder, and to the digital source, and a second multiplexer coupled to the encoder, to the decoder and to the medium interface.

As such and for at least the reasons described above and specifically that Rigatti and Hrusecky, alone or in any allowable combination, do not teach, suggest or make obvious a digital video recorder including at least an encoder, a decoder, a medium interface, a digital source and "a multiplexer coupled to the encoder and to the decoder and to the digital source and to the medium interface, wherein the multiplexer comprises a first switch, which selectively couples the decoder **directly** to the encoder or to the digital source **such that a signal from the encoder is able to be communicated to the decoder without prior recording**" as taught in the Applicant's Specification and claimed by at least the Applicant's claims 11, 17 and 21, the Applicant respectfully submits that independent claims 11, 17 and 21 fully satisfy the requirements of 35 U.S.C. § 103 and are patentable thereunder.

Furthermore, dependent claim 24 depends directly from independent claim 21 and recites additional features therefor. As such and for at least the reasons set forth herein, the Applicant submits that dependent claim 24 is also not rendered by the teachings of Rigatti and Hrusecky, alone or in any allowable combination. Therefore the Applicant submits that dependent claim 24 also fully satisfies the requirements of 35 U.S.C. § 103 and is patentable thereunder.

The Applicant reserves the right to establish the patentability of each of the claims individually in subsequent prosecution.

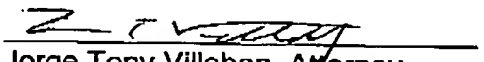
Conclusion

Thus the Applicant submits that none of the claims, presently in the application, are rendered obvious under the provisions of 35 U.S.C. § 103. Consequently, the Applicant believes that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion, it is respectfully requested that the Examiner telephone the undersigned.

No fee is believed due. However, if a fee is due, please charge the additional fee to Deposit Account No. 07-0832.

Respectfully submitted,
Frank Dumont

By: 
Jorge Tony Villabon, Attorney
Reg. No. 52,322
(609) 734-6445

Patent Operations
Thomson Licensing Inc.
P.O. Box 5312
Princeton, New Jersey 08543-5312

March 15, 2006